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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|------------------------|
| 10/670,129 | 09/23/2003 | Wei Yen | 57159-8008.US01 | 2562 |
| 22918 | 7590 | 09/12/2007 | | |
| PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026 | | | EXAMINER BOND, CHRISTOPHER H | |
| | | | ART UNIT 3714 | PAPER NUMBER |
| | | | MAIL DATE 09/12/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/670,129

Applicant(s)

YEN ET AL.

Examiner

Christopher H. Bond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>3/13/2007, 7/19/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The arguments and amendments have been entered on June 4, 2007. Claims 1-19, and 21 are still pending in the present application. Claim 20 has been cancelled.

Information Disclosure Statement

2. The Information Disclosure Statements filed March 13, 2007 and July 19, 2007 have been acknowledged.

Claim Objections

3. Claims 7 and 11 are objected to because of the following informalities: both describe 'the communication link' which lacks antecedent basis. For the purposes of examination, the Examiner assumes the applicant means --the communication interface-- which is the amended form of communication link appearing in the applicants' other claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants' limitation of "an audio-visual input interface, coupled to the housing, for receiving input from the local user to the control circuitry to control audio or video characteristics of an external display", as claimed in applicants'

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claim 1, and "an audio/video output interface, coupled to the housing, through which the local user provides input associated with control of the television", as claimed in applicants' claim 21, is not reasonably conveyed in the specification. While the Examiner recognizes the applicants' A/V output **113** and A/V interface **230**, disclosed in the specification, reexamination of the specification does not suggest that these parts are capable of performing the limitations listed above. Moreover, paragraph [0063] of the applicants' specification--that is, "Similarly, the audio/video interface 230 might include a known interface for operating in combination or conjunction with the display device 120, such as for example a direct audio or video output interface. As described above, the integrated console/controller 110 may alternatively or in addition include a speaker or other audio output, so there is no particular requirement for actual audio output to the display device 120," gives no indication that the audio/video interface may be used to control the audio or video characteristics of an external display device.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Sawano et al., USPAT 6,544,126 (Sawano).**

7. As to claim 1, Sawano presents a portable game machine with download capability and discloses (column 5, line 46 - column 6, line 38) that the, "Game system...includes a portable game machine...and a home video game machine...The portable game machine...maybe be, for example, a Nintendo...GAME BOY ADVANCE handheld portable video game system, and the home video game system...may be a...GAME CUBE 3D video game system...the portable handheld unit...and home video game unit...are linked. Connection is provided through a communication cable between a communication port...on a portable game machine...and a communication port...on a video game machine...Other connection means (e.g., RF, infrared, other wireless, etc.) are also possible. The portable game machine...has a game-machine body housing...sized to be held by the hand...The housing...has an LCD (Liquid Crystal Display)...constituting a display disposed on an upper portion of a first surface...thereof...A serial communication port...is provided in a side surface...of the main body. A user manipulated controller interface...is arranged in a lower portion on the front surface...of the housing...The example controller interface...in this embodiment, includes five operation keys....These operation keys...are to be manipulated, typically, by the thumbs or other digits of a game player who is holding the housing....an insertion aperture...is formed in an upper end of a backside...of the main body. In use, the insertion aperture...is used to insert a game memory cartridge...as a first information storage medium. Different games can be played on portable machine...by inserting

different cartridges...storing the different game." This would anticipate the applicants' claims of having an integrated console controller (portable game machine) comprising: a housing capable of being hand-held, with a location capable of receiving a cartridge, control circuitry (inherent part of machine); a player input interface (controller interface), and a network interface (communication port).

8. As to claim 2, Sawano discloses (column 7, lines 63-67) that, "The game cartridge...includes a ROM...and a RAM...(e.g., an SRAM). The ROM...stores, for example, a game program or other application. RAM...is available for storing backup data and may be non-volatile (e.g. battery backed)." This would anticipate the applicants' limitation wherein the cartridge includes at least some rewritable memory elements (RAM).

9. Regarding applicants' claims 3, 4, and 6-9, Sawano discloses (column 2, lines 31-41), "When operating in the "download mode", the portable game machine is capable of receiving executable code written to it by a data source (e.g. another portable game machine, a home video game machine, a personal computer, a network, etc.) The portable game machine writes the received executable code into an internal working random access memory and then proceeds to execute the code...this download capability permits multiple players to play a common video game on multiple video game units using only a single cartridge or other storage media" This anticipates the applicants' limitation further comprising software embodied in a computer-readable medium of the control circuitry that includes at least some elements that have been dynamically replaced or upgraded. This further anticipates the applicants' limitation of a

communication interface to at least one general purpose computing device; software including at least one element capable of supporting interactive communication between the integrated controller and the general purpose computing device (i.e. communication between the portable game machines). This further anticipates the applicants' limitation wherein the communication interface includes an input from a substantially remote supplemental console; the communication interface is capable of supporting a dynamic replacement or update of a software element of the software; the software includes at least one element capable of supporting a game with multiple consoles; the software includes at least one element capable of supporting a contest among multiple players, the contest being adjudicated at one of the integrated elements (game machine with cartridge).

10. As to applicants' claim 5, as discussed above and illustrated in Figure 1. of Sawano, the portable game machine and game machine may be linked. Sawano further discloses (column 6, lines 51-54), "The example video game machine...is coupled to an external display...such as a home television set, computer display or the like." This would anticipate the applicants' limitation wherein the communication interface includes an input from a substantially remote output device.

11. As to claims 11, and 13-15, as discussed above, what has been disclosed by Sawano anticipates the applicants' limitation of an integrated console controller including communication interface to at least one supplemental console (game machine), the communication interface being capable of supporting communication between the supplemental console and the integrated console controller (portable game

machine); wherein the communication interface includes an input from the supplemental console; further comprising software having at least one element of supporting a game with multiple consoles; further comprising software having at least one element capable of supporting a multiplayer game.

12. As to claim 12, Sawano discloses (column 7, lines 16-21), "An AV (Audio-Video) terminal, not shown, is provided in a rear surface...of the housing...The AV terminal is connected to an AV terminal of a TV monitor...through a cable...It is noted that the AV terminal may, in addition to delivering video signals and audio signals, transmit modulated signal versions of them." This would anticipate the applicants' limitation wherein the communication interface includes a direct audio or video output from the supplemental console to an output device.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 10, 16-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawano.**

15. As to claims 16, 18, and 21, as discussed above, Sawano anticipates the applicants' limitations a system comprised of: a hand-held integrated console controller (portable game machine); a general purpose computing device having memory

including software capable of receiving inputs from the hand-held integrated controller (game machine), the software including elements capable of generating a signal capable of being communicated to the external display device. Sawano further anticipates a system comprising: a television, a network, a workstation (personal computer) coupled to the network capable of running a contest (game) between users, a device associated with the user, coupled to the workstation via the network; and integrated consoler controller including: a housing with a hand-held form factor having a removable storage interface, wherein, in operation, a removable storage element is coupled to the integrated console controller via the removable storage interface; an interface device coupled to the housing capable of coupling the integrated console controller to the television, the workstation, and a supplemental console; control circuitry coupled to the housing comprising: memory storing software, a secure processor capable of executing or interpreting at least some instructions on the software, a player input interface, through which the user provides input associated with control of the workstation.

16. Sawano further discloses (column 8, line 18 - column 9, line 5), "The...initialize program area...includes an authentication code area...The authentication code area...in this example stores an authentication code such as image data...representative, e.g. of "NINTENDO". The authentication code is preferable encrypted and/or data-compressed...The authentication program stored in an area...of the boot ROM...is a program for carrying out authentication by the utilization of an authentication code provided in the area...the work RAM...of the portable game machine...includes an

authentication code area...In the...authentication code area...is stored an authentication code read out of the area...of the...ROM...upon executing the authentication program...The authentication code area...stores, in advance, the predetermined authentication code for comparison with the authentication code stored in the area...of the work RAM...upon executing the authentication program..." Sawano further discloses (column 13, lines 18-24) that, "...another game machine" in the invention may be any game machine to use an information storage medium storing an auxiliary program...including various game machines, such as portable game machines, stand-alone video game machines, personal computers, network connected appliances (i.e. servers), etc." This would further meet the applicants' limitation of a secure processor capable of executing or interpreting at least some instructions in the software, and capable of controlling operation of the software, whereby only authorized software can be executed or interpreted. This also meet the applicants' limitation further comprising a cartridge that includes at least some information capable of authenticating the software.

17. While Sawano does not explicitly disclose a network server for scoring an online multiplayer game by the user of a hand-held integrated console controller and one or more users, Sawano discloses the use of both servers and multiplayer games play in his invention. Thus, it would have been a matter of choice, well within the capabilities of one skilled in the art at the time the invention was made to use the server described in Sawano--which (the server) has been described as both a game machine and information storage medium--to score an online multiplayer game.

18. As to claim 17, as discussed above (Sawano, column 7, lines 63-67), the removable cartridge contains different types of memory. This would meet the applicants' limitation further comprising a cartridge that is insertable into and removable from the hand-held integrated console controller, wherein at least some of the memory is disposed within the cartridge.

19. As to claim 19, as previously discussed, Sawano discloses a portable game machine which is capable of downloading and updating existing software. Sawano also discloses, as discussed above (column 7, lines 63-67) that the cartridge includes RAM capable of saving backup data. These both would meet the applicants' limitation further comprising a cartridge that includes at least some information capable of replacing or upgrading the software.

20. As to claim 10, while Sawano discloses software where at least one element supports a multi-player game (contest), Sawano fails to explicitly disclose the limitation, wherein the contest includes a memory having an aggregate measure or a statistical measure of score achieved by multiple players, where each one of the multiple players are associated with an instance of a game. This is an obvious limitation, as an overwhelmingly large number of multiplayer games--especially games for the GAMEBOY ADVANCE portable gaming system as described in Sawano--contain aggregate measure or statistical measure of scores--for example, in regards to a racing game--score, place, rank, time, etc. This limitation is an obvious limitation common to a large number of multi-player games.

Response to Arguments

21. Applicant's arguments with respect to claim 1-19 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H. Bond whose telephone number is (571) 272-9760. The examiner can normally be reached on M-F 9:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Chris Bond


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